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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,038	03/17/2004	Christian Decker	13909-152001 / 2003P00916	3461
32864 7590 09/20/2007 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER LA, ANH V	
			ART UNIT 2612	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,038

Applicant(s)

DECKER ET AL.

Examiner

Anh V. La

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 and 87-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43, 87-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 8-23, 25, 27-34, 36, 38-43, and 87-89 are rejected under 35 U.S.C. 102(e) as being anticipated by Hull (US 7,129,840).

Regarding claim 1, Hull discloses a document management system comprising a physical-document monitoring device comprising a document coupling device (column 4, lines 6-12, col. 2, lines 35-42), a sensor (RFID tags, 112, 416) coupled to the document coupling device, the sensor operable to sense a state of a document and to generate a signal representative thereof, and a computer (col. 2, line 55) coupled to the sensor, the computer operable to determine the document state based on the signal.

Regarding claim 20, Hull discloses a method by which a physical-document monitoring device facilitates management of a physical document comprising sensing a state of the physical document (RFID tags, 112, 416), generating a signal representing the documents state, determining the document state based on the signal, and generating a wireless signal representing the document state (fig. 1-7).

Regarding claim 33, Hull discloses an article comprising a machine-readable medium storing instructions operable to cause a physical-document monitoring device

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comprising one or more machines to perform operations comprising determining whether a state of a document has been sensed (RFID tags, 112, 416), determining the document state, and generating a wireless message representing the document state (fig. 1-7).

Regarding claims 2, 22, Hull discloses the document coupling device being adapted to bind the document (col. 4, line 5-12, col. 6, line 45).

Regarding claims 3, 23, 34, Hull discloses the document state comprising the number of document pages (col. 9, lines 1-25).

Regarding claim 4, Hull discloses the sensor comprising the document coupling device (figures 1-7, col. 4, lines 6-12, col. 2, lines 35-42).

Regarding claim 8, Hull discloses a wireless communication device sending data from and receiving data for the computer (col. 3, lines 40-46).

Regarding claim 9, Hull discloses the sent data comprising the determined document state (figures 1-7).

Regarding claims 10, 28, 39, Hull discloses state data for a non-physical version of document (col. 4, lines 20-38).

Regarding claims 11, 27, 38, Hull discloses document meta-data (col. 4, lines 20-50, col. 8, lines 45-67).

Regarding claim 12, Hull discloses a text string (col. 4, lines 20-50, col. 8, lines 45-67).

Regarding claims 13, 25, 36, Hull discloses a document location (col. 5, lines 10-55, col. 8, lines 10-22).

Regarding claims 14, 29, 40, Hull discloses an allowable document state and storing the allowable document state (col. 4, lines 30-38).

Regarding claim 15, Hull discloses a rule that expresses the allowable document state (col. 4, lines 30-38).

Regarding claims 16, 30, 41, Hull discloses determining whether the allowable document state has been violated (col. 8, lines 10-32).

Regarding claims 17, 31, 42, Hull discloses a displaying device providing a visual indication of physical document status (col. 8, lines 10-38).

Regarding claim 18, Hull discloses a user input device (col. 7, lines 5-15).

Regarding claims 19, 32, 43, Hull discloses a wireless message (col. 7, lines 5-32).

Regarding claim 21, Hull discloses coupling a physical-document monitoring device to the document (fig. 1-7).

Regarding claims 87-89, Hull discloses a paper-base document (col. 4, lines 5-12).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hull in view of Murray (US 4,170,346).

Regarding claim 5, Hull discloses all the claimed subject matters as set forth above in the rejection of claim 1, but still does not disclose the sensor sensing the pages based on capacitance (claim 5). Murray teaches the use of the sensor sensing the pages based on capacitance (col. 3, lines 30-46). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the sensor sensing the pages based on capacitance to the system of Hull as taught by Murray for the purpose of effectively sensing the state of the document.

5. Claims 6-7, 26, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull in view of Back (US 6,262,662).

Regarding claims 6-7, 26, 37, Hull discloses all the claimed subject matters as set forth above in the rejection of claim 1, but still does not disclose an environmental condition of the document and the environmental condition comprising illumination. Back teaches the use of an environmental condition of a document and the environmental condition comprising illumination (abstract, col. 6, lines 25-46). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include an environmental condition of the document and the environmental condition comprising illumination to the system of Hull as taught by Back for the purpose of effectively sensing the state of the document.

6. Claims 24, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull in view of Wittmer (US 5,892,444).

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Regarding claims 24, 35, Hull discloses all the claimed subject matters as set forth above in the rejection of claim 23, but still does not disclose sensing an electrical value affected by a dielectric. Wittmer teaches the use of sensing an electrical value affected by a dielectric (col. 2, lines 30-67). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include sensing an electrical value affected by a dielectric to the system of Hull as taught by Wittmer for the purpose of effectively sensing the state of the document.

Answers to Remarks

7. Applicant's arguments filed July 09, 2007 have been fully considered.

Applicant's arguments with respect to claims 1-43 and 87-89 have been considered but are moot in view of the new ground(s) of rejection.

8. **THIS ACTION IS MADE NON-FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh V. La whose telephone number is (571) 272-2970.

The examiner can normally be reached on Mon-Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



ANH V. LA
PRIMARY EXAMINER

Anh V La
Primary Examiner
Art Unit 2612

AI
September 11, 2007